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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,221	11/21/2000	Hisashi Inoue	2000 1451A	9406

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/716,221

Applicant(s)

INOUE ET AL.

Examiner

Pramila Parthasarathy

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Advisory Action

1. This office action is in response to the after-final request for reconsideration filed on February 28, 2005. Applicant's request for consideration has been fully considered but they are not persuasive because of the following reasons:

2. Regarding independent claims 1, 3, 7, 9 13 and 15, applicant argued that the cited prior arts (CPA) [Nakamura et al. U.S. Patent Number 6,185,312, hereafter "Nakamura" and Barton 6,047,374, hereafter "Barton"] do not disclose or suggest that "authentication data is embedded in transform coefficients of frequency bands exclusively of the MRA", "a key data is embedded in transform coefficients of a lowest frequency band", "generating authentication data from the pseudo-random number series" and "a second type of data is embedded in transform coefficients of frequency bands other than the lowest frequency band".

3. CPA discloses

an authentication data generation from the pseudo-random number series (Fig. 3 # 31 and Column 5 lines 42 – 55);

a key data embedded in transform coefficients of a lowest frequency band (Fig. 3 #22, 23 and Column 6 lines 4 – 57);

an authentication (a second type of data) embedded in transform coefficients of the frequency bands (Fig. 6 – 10 and Column 8 line 31 – Column 17 line 46); and

4. Additionally, regarding claims 3, 9 and 15, CPA discloses

a key data extraction to extract key data embedded by the specific apparatus from transform coefficients of a lowest frequency band (Fig. 3 # 22, 23 and Column 6 lines 4 – 57),

generate a pseudo-random number series by using predetermined key data, and to generate authentication data from the pseudo-random number series (Fig. 3 # 31 and Column 5 lines 42 – 55 and Column 8 lines 45 – 56);

an embedded information extraction to extract embedded information embedded based on the key data by the specific apparatus from transform coefficients of the frequency bands exclusive of the MRA among the plurality of frequency bands (Barton Fig. 2 # 42, Column 4 lines 22 – 41 and Column 7 line 55 – Column 8 line 28);

5. Regarding key data, the random generator generates random number as the initial value (key) data (Nakamura Column 8 lines 45 – 56).

6. Applicant agrees that CPA disclose an apparatus for embedding watermark information in image data and generates random number for respective bits of watermark information, embedding watermark information in coefficients of a low frequency domain and authentication data.


7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

8. In this case, Nakamura's method of embedding digital image by embedding authentication information is combined with Barton's method for generating, embedding and extracting authentication information of a digital block (Barton Fig. 2, Column 4 lines

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22 – 41 and Column 7 line 55 – Column line 28), The motivation would be to provide security against unauthorized use or copying by providing tamper proof authentication information and to provide secure and reliable digital information.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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